

PATENT
Atty. Dkt. NO. EVRO/0006

REMARKS

Claims 1-33 are pending in the application and are subject to restriction and/or election requirement. The claims have been restricted under 35 U.S.C. §§ 121 and 372 as follows:

- I. Claims 1-7, 14, 18, 21, 24-25, and 29, drawn to nucleic codes encoding mutants of a non-fluorescent protein set forth as SEQ ID NO:2, cells and expression cassettes comprising said products and a method of use of said products;
- II. Claims 8, 10, 12, 13, 15, 17, 19, 20, 26, and 28, drawn to said protein and a method of use thereof; and
- III. Claims 9, 16, and 27, drawn to antibodies which specifically bind said protein.

The Examiner states that, in addition to inventions listed as Groups I-III above, each invention is additionally and independently directed to the following products which lack a special technical feature because each product has different optical (fluorescent) properties:

- (1) SEQ ID NO: 2 mutants with a substitution at position 222.
- (2) SEQ ID NO: 2 mutants with a substitution at position 220.
- (3) SEQ ID NO: 2 mutants with a substitution at position 148.

Applicants provisionally elect Group I (1), with traverse. Claims readable on the elected species include claims 1-7, 14, 18, 21, 24-25, 29 and 33. With respect to Groups I and II, proteins (Group II) and nucleic acids (I) encoding the same are closely related and possess a technical relationship involving one or more of the same or corresponding special technical features. No burden would exist for searching the inventions of both Groups I and II.

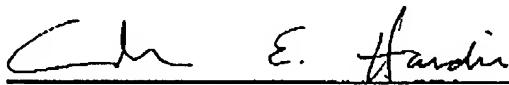
Regarding Groups (1-3), the Examiner misidentifies the special technical feature as "different optical (fluorescent) properties" instead of that the product has fluorescent properties, which is the common property to all alternatives claimed. Therefore, all the products claimed in the present application have the same major common feature, which is fluorescence ability. Furthermore, the invention as claimed relates to obtaining

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fluorescent mutants from a non-fluorescent protein (*i.e.*, all the alternatives share this significant aspect in common). Based on the foregoing, the requirement of a technical interrelationship and the same or corresponding special technical feature shall be considered met. M.P.E.P. § 1850 B.

Having addressed all issues set out in the office action, Applicants respectfully request withdrawal of the restriction. Applicants respectfully request prosecution of the pending claims.

Respectfully submitted,



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